IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Chen et al.**	§	
	§	Group Art Unit: **2626**
Serial No.: **10/617,530**	§	
	§	Examiner: **Neway, Samuel G.**
Filed: **July 10, 2003**	§	
	§	Confirmation No.: **3554**
For: **Traditional Chinese/Simplified Chinese Character Translator**	§	

37945

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Reinstatement of Appeal, filed in this case herewith.

A fee of $30.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0457. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0457.

No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0457.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

This appeal has no related proceedings or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application are: 1-5, 9-12, 16-20, and 24-27

B. STATUS OF ALL THE CLAIMS IN APPLICATION

Claims canceled: 6-8, 13-15, 21-23, and 28-30

Claims withdrawn from consideration but not canceled: None

Claims pending: 1-5, 9-12, 16-20, and 24-27

Claims allowed: None

Claims rejected: 1-5, 9-12, 16-20, and 24-27

Claims objected to: None

C. CLAIMS ON APPEAL

The claims on appeal are: 1-5, 9-12, 16-20, and 24-27

STATUS OF AMENDMENTS

No amendment after the Final Office Action of April 8, 2009 was filed. Accordingly, the claims on appeal are as amended in the Response to Office Action filed January 29, 2009. There are no un-entered amendments.

SUMMARY OF CLAIMED SUBJECT MATTER

A. CLAIM 1 - INDEPENDENT

The subject matter of claim 1 is directed to a computer implemented method comprising:

using a computer having a display and connected to the Internet *(FIG. 1, FIG. 2, 106)*, copying a Chinese character from a web page by highlighting the Chinese character on the web page (*Specification, 9:19-10:22, 10:7-27)*;

accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area *(FIG. 4, 302, 304, 306, 308)*;

pasting the Chinese character into the input field of the graphical user interface on the display and clicking the submit control *(Specification 7:7-22; 9:19-10:22; Fig. 4)*;

responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control *(FIG. 4, 302, 304, 306, 308)*, automatically recognizing the Chinese character without entering an encoding format of the Chinese character *(Specification 10:7-22)* so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area *(FIG. 4, 306, 308; page 5, 5-15, page 8:23-9:15)* and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character *(FIG. 4, 306, 308; page 5, 5-15, page 8:23-9:15)*, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character (*FIG. 4, 306, 308; page 5, 5-15, page 8:23-9:15).*

B. CLAIM 16 - INDEPENDENT

The subject matter of claim 1 is directed to a program product operable on a computer, the program product comprising *(FIG. 1, FIG. 2, 106)*:

a computer-usable medium *(FIG. 1, FIG. 2, 106)*;

wherein the computer usable medium comprises instructions encoded thereon to cause a

computer, having a display and connected to the Internet, to perform the following:

responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control *(FIG. 4, 302, 304, 306, 308*), automatically recognizing the Chinese character without entering an encoding format of the Chinese character *(Specification 10:7-22)* so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area *(FIG. 4, 306, 308; page 5, 5-15, page 8:23-9:15)* and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character *(FIG. 4, 306, 308; page 5, 5-15, page 8:23-9:15)*, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character *(FIG. 4, 306, 308; page 5, 5-15, page 8:23-9:15).*

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to review on appeal are as follows:

A. GROUND OF REJECTION 1 (Claims 1-5, 9-12, 16-20, and 24-27)

The Examiner has provisionally rejected claims 1-5, 9-12, 16-20, and 24-27 on the ground of nonstatutory obviousness-type double-patenting as being unpatentable over claims 1-16 and 20-45 of copending application no. 10/617,526 in view of Chinese-English Dictionary, http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html (hereinafter "*Chinese-English Dictionary*"), and further in view of Chinese-English Lookup, http://web.archive/org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm, (hereinafter "*Lookup*").

B. GROUND OF REJECTION 2 (Claims 1-3, 9, 10, 16-18, 24, and 25)

The Examiner has provisionally rejected claims 1-3, 9, 10, 16-18, 24, and 25 on the ground of nonstatutory obviousness-type double-patenting as being unpatentable over claims 1, 5, 6, 26, 30, and 31 of copending application no. 10/631,070 in view of Chinese-English Dictionary, http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html (hereinafter "*Chinese-English Dictionary*"), and further in view of Chinese-English Lookup, http://web.archive/org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm, (hereinafter "*Lookup*").

C. GROUND OF REJECTION 3 (Claims 1-5, 9-12, 16-20, and 24-27)

The Examiner has rejected claims 1-5, 9-12, 16-20, and 24-27 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

D. GROUND OF REJECTION 4 (Claims 1-4, 9-11, 16-19, and 24-26)

The Examiner has rejected claims 1-4, 9-11, 16-19, and 24-26 under 35 USC § 103 as being unpatentable over Chinese-English Dictionary, http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html

(hereinafter "*Chinese-English Dictionary*"), and further in view of Chinese-English Lookup, http://web.archive/org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm, (hereinafter "*Lookup*").

E. GROUND OF REJECTION 5 (Claims 1-4, 9-11, 16-19, and 24-26)

The Examiner has rejected claims 5, 12, 20, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Chinese-English Dictionary*, Page 16 (http://web.archive.org/web/20000301 054545/http://www.mandarintools.com/worddict.html) in view of Chinese-English Lookup (http://web.archive.org/web/2001 03091 04519/http://home.iprimus.com.au/richwarm/cel/cel.htm) referred as "*Lookup*" hereinafter and in further view of Hughes ("11CT3 ComputerScience Sample Paper I", 1998, University of Dublin).

ARGUMENT

A. GROUND OF REJECTION 1 (Claims 1-5, 9-12, 16-20, and 24-27)

The Examiner has provisionally rejected claims 1-5, 9-12, 16-20, and 24-27 on the ground of nonstatutory obviousness-type double-patenting as being unpatentable over claims 1-16 and 20-45 of copending application no. 10/617,526 in view of Chinese-English Dictionary, http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html (hereinafter "*Chinese-English Dictionary*"), and further in view of Chinese-English Lookup, http://web.archive/org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm, (hereinafter "*Lookup*").

Final Office Action dated April 8, 2009, pp. 3-6.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428,46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046,29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438,164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528,163 USPQ 644 (CCPA 1969).

Claims 1 and 16 contain the same distinguishing limitations. Therefore, the arguments presented for claim 1 apply to claim 16 as well. Claim 1 recites:

> A computer implemented method comprising:
>
> using a computer having a display and connected to the Internet, copying a Chinese character from a web page by highlighting the Chinese character on the web page;
>
> accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area;
>
> pasting the Chinese character into the input field of the graphical user interface on the display and clicking the submit control;
>
> responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese

equivalency display area and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character.

Appellants submit that claims 1 and 16 are patentably distinct and not obvious over the claims of co-pending application 10/617,526 for two reasons. Claims 1 and 16 recite features that are not present in the claims of co-pending application 10/617,526. Specifically, the limitation "responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character" is not anticipated or rendered obvious by the claims of co-pending application 10/617,526. Furthermore, the non-obviousness of claims 1 and 16 are further explained below in Section D of this brief.

B. GROUND OF REJECTION 2 (Claims 1-3, 9, 10, 16-18, 24, and 25)

The Examiner has provisionally rejected claims 1-3, 9, 10, 16-18, 24, and 25 on the ground of nonstatutory obviousness-type double-patenting as being unpatentable over claims 1, 5, 6, 26, 30, and 31 of copending application no. 10/631,070 in view of Chinese-English Dictionary, http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html (hereinafter "*Chinese-English Dictionary*"), and further in view of Chinese-English Lookup, http://web.archive/org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm, (hereinafter "*Lookup*").

Final Office Action dated April 8, 2009, pp. 6-10.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428,46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046,29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438,164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528,163 USPQ 644 (CCPA 1969).

Claims 1 and 16 contain the same distinguishing limitations. Therefore, the arguments presented for claim 1 apply to claim 16 as well. Claim 1 recites:

> A computer implemented method comprising:
>
> using a computer having a display and connected to the Internet, copying a Chinese character from a web page by highlighting the Chinese character on the web page;
>
> accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area;
>
> pasting the Chinese character into the input field of the graphical user interface on the display and clicking the submit control;
>
> responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character.

Appellants submit that claims 1 and 16 are patentably distinct and not obvious over the claims of co-pending application 10/631,090 for two reasons. Claims 1 and 16 recite features that are not present in the claims of co-pending application 10/631,070. Specifically, the limitation "responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character" is not anticipated or rendered obvious by the claims of co-pending application 10/617,526. Furthermore, the non-obviousness of claims 1 and 16 are further explained below in Section D of this brief.

C. GROUND OF REJECTION 3 (Claims 1-5, 9-12, 16-20, and 24-27)

The Examiner has rejected claims 1-5, 9-12, 16-20, and 24-27 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

Final Office Action dated April 8, 2009, pp. 10-11.

The Examiner stated:

> Independent claims 1 and 16 recite the limitations "recognizing the Chinese character without entering an encoding format of the Chinese character". The specification does not disclose this limitation. The closest teaching to this limitation is the fact that the Chinese character can be recognized regardless of the encoding format, i.e. whatever the encoding of the Chinese character the invention will recognize the character (page 10, lines 7-9). However, the specification is silent on entering or not entering an encoding format. Applicant is reminded that a mere absence of a positive recitation is not basis for exclusion. In other words, the lack of disclosure regarding recognizing a Chinese character by entering an encoding format is not enough to teach recognizing without entering an encoding format.
> The other claims are rejected based on their dependence upon rejected claims.

In regard to negative limitations, the MPEP states the following:

> 2173.05(i) Negative Limitations
>
> The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).
>
> A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. In re Wakefield, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

> Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Therefore, Appellants submit that the limitation "recognizing the Chinese character without entering an encoding format of the Chinese character" is proper because the limitation (1) makes the boundaries of the patent clear, and (2) has a basis in the original disclosure.

First, the claim limitation makes the boundaries of the patent clear. For example, claim 1 recites:

> A computer implemented method comprising:
>
> using a computer having a display and connected to the Internet, copying a Chinese character from a web page by highlighting the Chinese character on the web page;
>
> accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area;
>
> pasting the Chinese character into the input field of the graphical user interface on the display and clicking the submit control;
>
> responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character.

The claim limitation, when read in context of the entire claim, specifies that once a Chinese character is pasted into the input field, and once the submit control is clicked, then the invention will automatically recognize the Chinese character. Further, the claim specifies that the recognition will take place without entering an encoding format of the Chinese character. Thus the claim limitation makes the boundaries of the invention clear and precise. The limitation does not attempt to define the invention by what it is not, but rather by limiting the inputs necessary to define how it operates. Indeed, it is the ability of the invention to perform with only two inputs which is the novelty of the invention.

Second, the claim limitation has a basis in the original disclosure. Appellants' FIG. 4 below, shows a single input of a character by cutting and pasting and the activation of the single submit button causes a display of both Simplified Chinese and Traditional Chinese. No entry of an encoding format of the Chinese character is required, nor could such an entry be made because there is no provision for such an entry in the graphical user interface. This absence of an input field for an encoding format is clearly displayed by FIG. 4.

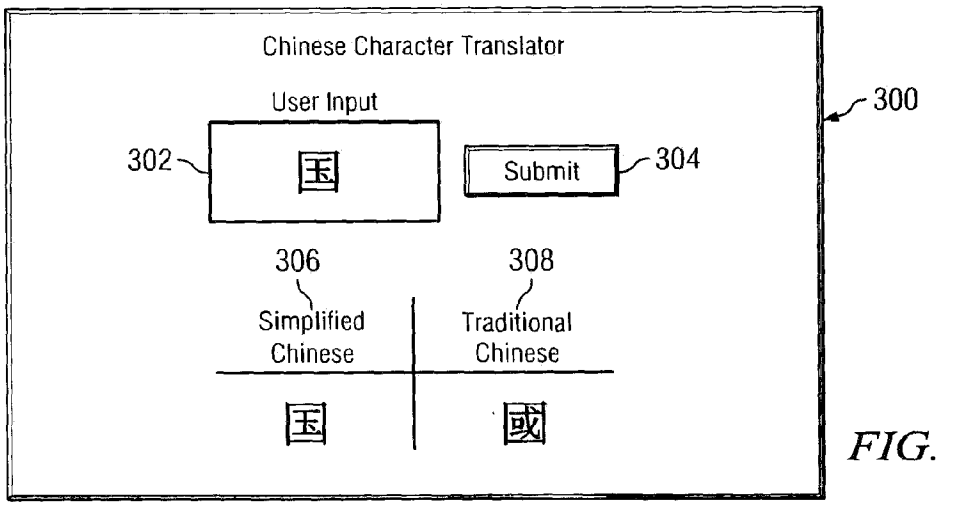

FIG. 4

Moreover, in regard to the absence of an input of an encoding format, the Specification states the following:

> Turning to FIG. 4, an embodiment of Graphical User Interface (GUI) 300 of the present invention is illustrated. GUI 300 is an example of the contents of the web page embodiment of the present invention. GUI 300 is also an example

> of the display of the stand-alone computer program embodiment of the present invention which is operable on a single computer. GUI 300 contains a user input field 302. The user may input a character into user input field 302 utilizing the copy-and-paste operation of a computer. In a copy-and-paste operation, the user highlights the desired character, chooses "copy" from a menu, places the cursor in user input field 302, and selects "paste" from a menu. The highlighted character then appears in user input field 302. Persons of ordinary skill in the art are aware of methods for implementing copy-and-paste operations on a computer. The user may also input the character into user input field 302 by any method known by persons of ordinary skill in the art.
>
> As part of the present invention, when the user utilizes the copy-and-paste operation to input a character into user input field 302, CCP 200 will recognize the entered character regardless of the encoding format used in the highlighted "copy" text. For example, a user may be viewing another web page written in Traditional Chinese and come across a character the user does not recognize. The user may then highlight the unrecognized character, copy the character, paste the character in user input field 302, and click submit button 304 to determine the Simplified Chinese character equivalent for the Traditional Chinese character.

Specification, page 9, line 19 to page 20, line 22.

Specifically, the specification states "[a]s part of the present invention, when the user utilizes the copy-and-paste operation to input a character into user input field 302, CCP 200 will recognize the entered character regardless of the encoding format used in the highlighted 'copy' text." Thus the specification clearly states that the invention will operate to recognize the character regardless of the format. FIG. 4 does not provide for an entry of an encoding format, and therefore, the invention must operate without such an entry.

Since the claim limitation meets the two requirements for an acceptable negative limitation, the Examiner's rejection under 35 USC 112 should be overturned.

D. GROUND OF REJECTION 4 (Claims 1-4, 9-11, 16-19, and 24-26)

The Examiner has rejected claims 1-4, 9-11, 16-19, and 24-26 under 35 USC § 103 as being unpatentable over Chinese-English Dictionary, http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html (hereinafter "*Chinese-English Dictionary*"), and further in view of Chinese-English Lookup, http://web.archive/org/web/20010309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm, (hereinafter "*Lookup*").

Final Office Action dated April 8, 2009, pp. 11-17.

Claims 1 and 16 contain the same distinguishing limitations. Therefore, the arguments presented for claim 1 apply to claim 16 as well. Claim 1 recites:

> A computer implemented method comprising:
>
> using a computer having a display and connected to the Internet, copying a Chinese character from a web page by highlighting the Chinese character on the web page;
>
> accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area;
>
> pasting the Chinese character into the input field of the graphical user interface on the display and clicking the submit control;
>
> responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character.

Claim 1 is representative of 16. Claim 1 distinguishes over the cited art. The first cited reference is *Chinese-English Dictionary*. *Chinese-English Dictionary* discloses the following:

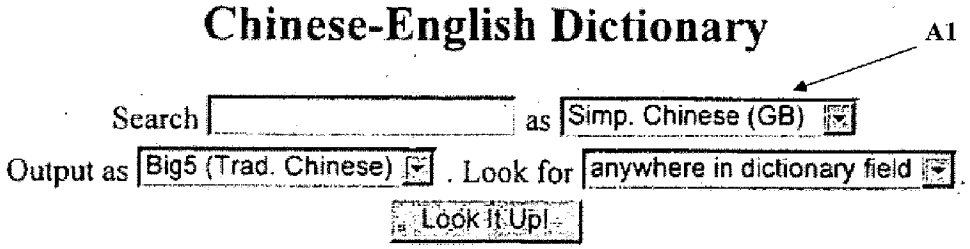

Figure A: page 1 of the Chinese-English Dictionary Web Page

Appellants do not claim the format of the *Chinese-English Dictionary*. Rather, as set forth in Appellants' FIG. 4 below, a single input of a character by cutting and pasting and the activation

of the single submit button causes a display of both Simplified Chinese and Traditional Chinese.

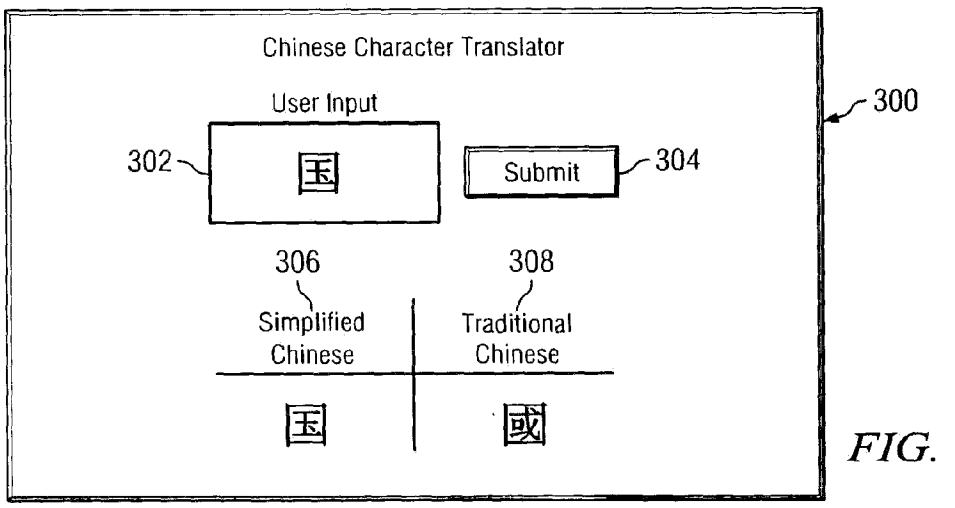

FIG. 4

Specifically, Appellants eliminate the selection marked A1 in the *Chinese-English Dictionary*. The cited art does not disclose a graphical user interface that will operate without the input A1 of *Chinese-English Dictionary*. Moreover, contrary to the Examiner's position, the elimination of the input A1 is not obvious to a person skilled in the art. The Examiner states that "[i]t would also have been obvious to limit the graphical user interface (GUI) to an input field, a submit control, and an equivalency display area in order to provide a simple GUI void of unnecessary encumbrances." We disagree with the Examiner because the fields cannot be eliminated in the *Chinese-English Dictionary* without changing the method of operation. Nor can *Lookup* be combined with the *Chinese-English Dictionary* to produce the claimed invention. *Lookup*, cited by the Examiner for the pasting feature of the Chinese character, is set forth below:

What is CEL?

CEL is a **Chinese-English dictionary search utility** that is designed to help Chinese language learners to read Chinese electronic texts in other applications such as Web browsers and word processors.

In the illustration, the user has

> selected and copied a word in Notepad. CEL, having detected the word on the Windows Clipboard, has popped up to display the corresponding dictionary entry.

Lookup, page 1.

Lookup discloses selecting and copying a word in Notepad. Then CEL, having detected the word on the Windows Clipboard, pops up to display the corresponding dictionary entry. The Examiner has set forth no technical argument to show how *Lookup* and the *Chinese-English Dictionary* can be modified to produce a graphical user interface as claimed by Appellants. Rather, as will be analyzed below, the Examiner has premised his rejection on an impossible combination.

The Examiner's rejection is based on the premise that *Chinese-English Dictionary* and Lookup can be combined to create the claimed invention. Specifically, the Examiner states:

> Chinese-English Dictionary and Lookup do not explicitly disclose a graphical user interface (GUI) having only an input field, a submit control, and an equivalency display area. However, it would have been obvious to one with ordinary skill in the art at the time of the invention to have excluded unnecessary fields from the Chinese-English Dictionary's GUI in order to present a simple interface void of unused fields. For instance, the "as" field in Chinese-English Dictionary where a user selects the encoding type of the entered Chinese character will be unnecessary in the combination of Chinese-English Dictionary with Lookup, because the combination, using Lookup's method, is able to automatically discern the entered Chinese character's encoding. The "Output as" field will also be unnecessary because the combination of Chinese-English Dictionary with Lookup is able to display the Chinese character and all its translations so the user is not required to select which particular translations should be displayed. The "Look for" field which is used to select the position of the entered Chinese character is not a mandatory field for translation in Chinese-English Dictionary, it is simply a way to limit searches. This field could be omitted without affecting Chinese-English Dictionary's basic translation capabilities. It is again noted that it is well settled that the omission of an element/step and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

Final Office Action dated April 8, 2009.

The Examiner premise is that it would be obvious to take away a field in order to exclude unnecessary fields. However, the field is absolutely necessary for the Chinese English Dictionary. Thus, the Examiner cites Lookup to remedy the deficiency. The mistake that the Examiner has

made is that the dictionary displays the character cut and pasted into the Windows notepad, a phonetic version and an English meaning. However, the traditional Chinese character is not available. Appellants' claimed invention is not about obtaining a pronunciation or a dictionary meaning. Appellants' claimed invention is about Simplified Chinese/Traditional Chinese equivalency. Chinese is a character language. Simplified Chinese characters are not the same as Traditional Chinese characters. Lookup wholly fails to address Simplified Chinese/Traditional Chinese equivalency, and therefore, even if it could be technically combined with the Chinese English Dictionary, it would not be able to function as claimed in claims 1 and 16.

Therefore, for at least three reasons, claims 1 and 16 distinguish over the cited art.

First, the cited art, individually or in combination, fails to teach or suggest the limitation, "accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display are." Specifically, none of the cited references teach or suggest a graphical user interface that only has an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area. The cited art cannot be combined to produce a graphical user interface that has only those elements.

Second, the cited art, individually or in combination, fails to teach or suggest the limitation "responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control...." The cited art requires more steps in order to accomplish the translation, and will not work with only the actions specified in the claim.

Third, the cited art, individually or in combination, fails to teach or suggest the limitation "automatically recognizing the Chinese character without entering an encoding format of the Chinese character …." The cited art must enter an encoding format in order to function as disclosed. Moreover, the cited art cannot work in response to only those actions specified in the claim.

E. GROUND OF REJECTION 5 (Claims 5, 12, 20, and 27)

The Examiner has rejected claims 5, 12, 20, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chinese-English Dictionary Page 16 (http://web.archive.org/web/20000301 054545/http://www.mandarintools.com/worddict.html) in view of Chinese-English Lookup (http://web.archive.org/web/2001 03091 04519/http://home.iprimus.com.au/richwarm/cel/cel.htm) referred as Lookup hereinafter and in further view of Hughes ("11CT3 Computer Science Sample Paper I", 1998, University of Dublin).

Claims 5 and 12 recite "wherein the conversion table is a JAVA hashtable." Hughes discloses a conversion table for Morse Code that can be stored in a JAVA hashtable. Appellants submit that the art is not in related field, and that it would not be obvious to look to Morse Code in designing a Chinese equivalency tool. Moreover, Claims 5 and 12 depend from claim 1. Claims 10 and 27 depend from claim 16. Appellants submit that claims 5 and 12 are allowable for the reasons set forth above in regard to claim 1, and that claims 20 and 17 are allowable for the reasons set forth in regard to claim 16 above.

F. CONCLUSION

As shown above, the Examiner has failed to state valid rejections against any of the claims. Therefore, Appellants request that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellants request that the Board direct the Examiner to allow the claims.

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Respectfully submitted,

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CLAIMS APPENDIX

The text of the claims involved in the appeal is as follows:

1. A computer implemented method comprising:

using a computer having a display and connected to the Internet, copying a Chinese character from a web page by highlighting the Chinese character on the web page;

accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area;

pasting the Chinese character into the input field of the graphical user interface on the display and clicking the submit control;

responsive only to pasting the Chinese character into the input field of the graphical user interface and clicking the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Traditional Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character equivalent is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character.

2. The method of claim 1 further comprising: accepting the Chinese character as user input, wherein the Chinese character is encoded in GB2312 or Unicode.

3. The method of claim 1 further comprising: translating the Chinese character from GB2312 to Unicode.

4. The method of claim 1 further comprising: accessing a conversion table to determine the Traditional Chinese character.

5. The method of claim 4 wherein the conversion table is a JAVA hashtable.

9. The method of claim 1 further comprising: accepting the Chinese character as user input, wherein the Chinese character is encoded in Big 5.

10. The method of claim 1 further comprising: translating the Chinese character from Big 5 to Unicode.

11. The method of claim 1 further comprising: accessing a conversion table to determine the Simplified Chinese character.

12. The method of claim 11 wherein the conversion table is a JAVA hashtable.

16. A program product operable on a computer, the program product comprising:

a computer-usable medium;

wherein the computer usable medium comprises instructions encoded thereon to cause a computer, having a display and connected to the Internet, to perform the following:

responsive to a user copying a Chinese character from a web page by highlighting the Chinese character on the web page and accessing a graphical user interface having only an input field, a submit control, and a Simplified Chinese/Traditional Chinese equivalency display area, and further responsive only to pasting the Chinese character into an input field of a graphical user interface on the display and activating the submit control, automatically recognizing the Chinese character without entering an encoding format of the Chinese character so that when the Chinese character is a Simplified Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Traditional Chinese character is simultaneously displayed in the Simplified Chinese/Traditional Chinese equivalency display area next to the Chinese character ~~in~~, and when the Chinese character is a Traditional Chinese character, the Chinese character is displayed in the Simplified Chinese/Traditional Chinese equivalency display area and the Simplified Chinese character is simultaneously displayed next to the Chinese character in the Simplified Chinese/Traditional Chinese equivalency display.

17. The program product of claim 16 further comprising: instructions for accepting the Chinese character as user input, wherein the Chinese character is encoded in GB2312 or Unicode.

18. The program product of claim 16 further comprising: instructions for translating the Chinese character from GB2312 to Unicode.

19. The program product of claim 16 further comprising: instructions for accessing a conversion table to determine the Traditional Chinese character.

20. The program product of claim 19 wherein the conversion table is a JAVA hashtable.

24. The program product of claim 16 further comprising: instructions for accepting the Chinese character as user input, wherein the Chinese character is encoded in Big 5.

25. The program product of claim 16 further comprising: instructions for translating the Chinese character from Big 5 to Unicode.

26. The program product of claim 16 further comprising: instructions for accessing a conversion table to determine the Simplified Chinese character.

27. The program product of claim 26 wherein the conversion table is a JAVA hashtable.

EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131, or 1.132 is being submitted.

Evidence entered and relied upon by the Examiner includes:

http://web.archive.org/web/20000301054545/http://www.mandarintools.com/worddict.html referred to as Chinese English Dictionary;

http://web.archive.org/web/2001 0309104519/http://home.iprimus.com.au/richwarm/cel/cel.htm referred as Lookup; and

11CT3 Computer Science Sample Paper I", 1998, University of Dublin) referred to as Hughes.

RELATED PROCEEDINGS APPENDIX

This appeal has no related proceedings.